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RADER FISHMAN & GRAUER PLLC			OSELE, MARK A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 3-6, filed August 8, 2006, with respect to the rejection(s) of claim(s) 1-38 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly cited prior art as follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5, 16-18, 20, 23-25, 29, 33 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Wien (U.S. Patent Publication 2002/0179242). Wien shows a mark transfer tool for transferring a transfer mark on a mark transfer tape onto a sheet of paper or the like, comprising: a hand-held case, 58, to be handled by one hand; a pay-out reel, 60, of mark transfer tape rotatably installed in the case; a winding reel, 84, for collecting the used mark transfer tape rotatably installed in the case; and a transfer

Art Unit: 1734

head, 82, for pressing and transferring the mark transfer tape paid out from the pay-out reel onto the transfer area, 54, being disposed in the leading end portion of the case, wherein the mark transfer tape, 62, has a peelable transfer mark layer of multiple pressure-sensitive adhesive transfer marks, 68, adhesively held on the surface side of a base tape, 64, this transfer mark layer is formed by integrally laminating at least a pressure-sensitive adhesive layer, 66, of pressure-sensitive adhesive material, and a mark array layer of multiple marks, 68, consecutively arranged at specific intervals in the running direction of the base tape, the adhesive force PA of the pressure-sensitive adhesive layer on the transfer area, the adhesive force PC of the transfer mark layer and base tape, and the adhesive force PD of the pressure-sensitive adhesive layer and base tape are set in the relation of $PA \geq PC \geq PD$, and the transfer mark layer being composed of material cut off by a transfer operation of the transfer head at the time of mark transfer, and the elongation rate of the transfer mark layer is set in a visual deformation allowable range of the transfer mark at the time of pressing and transferring of the transfer mark layer by the transfer head. It is noted that the adhesive forces PA, PC, and PD are not disclosed but are inherent from the disclosure that the mark transfer layer separates from the base tape upon pressing the mark transfer layer onto the transfer area (Figs. 7A-7D) and the fact that the mark transfer layer separates from the reverse side of the base tape upon unrolling the mark transfer tape from the pay-out reel.

Regarding claims 5 and 33, the transfer mark is composed of indication marks only.

Regarding claim 16, the transfer head does not rotate.

Regarding claims 17 and 18, the transfer head is at an angular position for pressing the mark transfer tape either parallel or orthogonal to the gripping surface of the case dependent upon whether the user holds the case by the sides or from the top and bottom.

Regarding claim 20, the pay-out reel and winding reel are installed in a disposable case and the transfer head is at the leading end of the case.

Regarding claim 21, as shown above, the instantly claimed mark transfer tape is shown by Wien.

Regarding claims 23 and 24, the transfer mark layer is formed by laminating the mark array layer with the transparent pressure sensitive adhesive layer and the mark transfer layer is separably adhered to the base tape by way of the pressure sensitive adhesive layer (See Fig. 4B).

Regarding claim 25, the transfer mark layer is formed by laminating the mark array layer with the pressure sensitive adhesive layer and the mark transfer layer is separably adhered to the base tape by way of the mark array layer (See Fig. 4A).

Regarding claim 29, the transfer mark layer is formed by integrally laminating sequentially the mark array layer, surface forming layer, 77, and the pressure sensitive adhesive layer and the mark transfer layer is separably adhered to the base tape by way of the mark array layer (See Fig. 4C).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 4, and 30, 31, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of von Hofe (U.S. Reissue Patent 28,732). Wien fails to show a plurality of cutting lines between the transfer marks. The reissue patent to von Hofe shows that when cutting labels on a continuous web, the labels can either be abutting or spaced apart by a plurality of cut lines forming a gap, 31 (See Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a plurality of cut lines between the transfer marks of Wien because von Hofe teaches that label printing cylinders are usually of a set diameter, the circumference of which may be divisible by the desired length of labels or transfer marks. When there is a remainder after dividing the circumference by the desired length of the labels, von Hofe suggests creating spaces between the labels (column 4, line 48 to column 5, line 44). Regarding claim 4, the length of the gap would be expected to be longer than the narrow transfer edge of Wien.

6. Claims 6, 7, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Baker (U.S. Patent 5,282,631). Wien fails to show the transfer mark to have overwriting spaces. Baker shows an adhesive tape on a base

tape wherein indication marks, 24, are interspersed with overwriting spaces, 20 (See Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add overwriting spaces to the indication marks of Wien because Baker teaches that user modifiable mark transfer layers are desirable for personalized or uniquely identifiable transfer marks.

7. Claims 9 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Doniger (U.S. Patent Publication 2001/0053644). Wien fails to show the transfer mark to have an aromatic effect. Doniger teaches printing of aromatic chemicals onto labels (columns 0009, 0010, 0018) such as those contained in a roll (paragraph 0026). Doniger teaches the value in aromatic labels is that the label can be applied to a user's skin, clothing, or possessions to create an aromatic effect without having to apply the fragrance directly to their skin or clothing (paragraph 0027). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the label of Wien with an aromatic chemical as taught by Doniger to allow for fragrant labels to be applied to an object of the user's choice.

8. Claims 10 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of either Ueda et al. (U.S. Patent 5,968,244) or Ochiai et al. (U.S. Patent 5,962,137). Wien fails to show antibacterial agents in the ink. Ueda et al. teaches that an antibacterial chemical in ink improves the stability of ink by mildew-proofing the ink (column 3, line 62 to column 4, line 4). Ochiai et al. teaches that an

Art Unit: 1734

antibacterial chemical in ink allows for the ink to be used in printing an article to be used in hospitals without spreading infections (column 1, lines 46-56; column 2, lines 14-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add antibacterial agents to the ink of Wien to improve the stability of ink as taught by Ueda et al. and/or to allow the ink to be used on articles intended for use in hospitals as taught by Ochiai et al.

9. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Ono et al. (U.S. Patent 5,430,904). Wien fails to show the pressing element to be an elastically deformable. Ono et al. shows an apparatus for transferring a layer from a backing web wherein the transfer head comprises an elastic pressing portion, 6, over a linear transfer head, 4b (column 8, lines 40-59). Ono et al. teaches that this arrangement allows complete transfer across the substrate even if the substrate is unsmooth or slightly curved (column 3, line 58 to column 4, line 31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the elastic pressing portion on a linear transfer head in the apparatus of Wien to realize the advantages shown by Ono et al.

10. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Narita et al. (U.S. Patent Publication 2002/0033237). Wien fails to show the pressing element to be an elastic roller. Narita et al. shows an apparatus for transferring a layer from a backing web wherein the transfer head comprises a resilient

cylindrical roller, 11, over a wire transfer head, 10b. Narita et al. teaches that this arrangement allows smooth movement across the substrate while maintaining a narrow pressing width to allow a user to precisely position the transfer device (paragraph 0022). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the elastic roller on a wire transfer head in the apparatus of Wien to realize the advantages shown by Narita et al.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Yoo (U.S. Patent 5,795,085). Wien fails to show a rotatable transfer head. Yoo shows an apparatus for transferring a layer from a backing web wherein the transfer head is rotatable to accommodate transfer to a substrate in either a horizontal or a vertical motion across the substrate (column 3, lines 8-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the transfer head of Wien rotatable to make it easy to use the apparatus for motion in any direction across a substrate as shown by Yoo.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Kozaki (U.S. Patent 6,363,990). Wien fails to show a refillable cartridge. Kozaki shows an apparatus for transferring a layer from a backing web wherein the pay-out reel, 36a, and winding reel, 36b, are contained in a replaceable tape cartridge, 30 (See Figs. 5, 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a replaceable tape cartridge for the pay-out reel and winding

Art Unit: 1734

reel of the mark transfer tape of Wien so a housing can be reused, thereby saving money and resources.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wien in view of Krish et al. (U.S. Patent 6,187,432). Wien fails to disclose the composition of the adhesive layer but suggests using the adhesive of Krish et al. (paragraph 0034). Krish et al. teaches that a suitable adhesive comprises a rubbery resin (column 5, lines 15-21) and a glassy resin (column 5, lines 25-38) in combination (column 5, lines 6-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the composition of Krish et al. in the article of Wien because Wien directs one of ordinary skill in the art to the disclosure of Krish et al. for acceptable adhesives. Regarding the limitation of adjusting the composition to reach a desired elongation rate, method of manufacturing limitations are not given patentable weight in an article claim.

Allowable Subject Matter

14. Claims 8, 26-28, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggests an overwriting space in the transfer mark to be a

Art Unit: 1734

window penetrating through the face and back sides of the transfer mark. Regarding claims 26-28, Hilberg shows a base tape holding a transfer mark layer disposed between an adhesive layer and a surface forming layer but fails to suggest the elongation rates of the mark layer or surface forming layer.

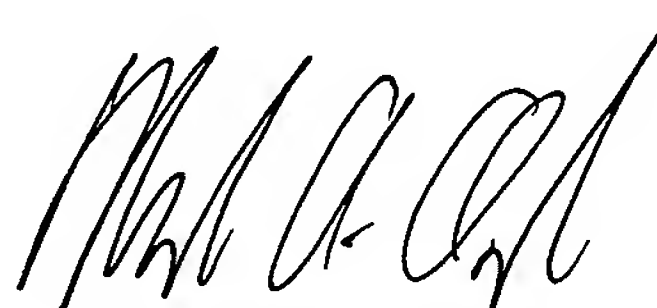
Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1734

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MARK A. OSELE
PRIMARY EXAMINER

August 29, 2006